UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,706	08/31/2001	Terunori Fujita	1155-0222P	9790

2292 7590 08/25/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER
PASTERCZYK, JAMES W

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/942,706	Applicant(s) Fujita et al.
	Examiner J. Pasterczyk	Art Unit 1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above, claim(s) *15* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-14* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-15* are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *Aug 31, 2001* is/are a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. *09/065,593*.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14, drawn to a catalyst, classified in class 502, subclass 103.

II. Claim 15, drawn to an olefin polymerization process, classified in class 526, subclass various depending on the species of cocatalyst and the particulars of the catalyst used.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product, such as a metallocene, Ziegler-Natta, or chromium oxide catalyst.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Robert Goozner, Esq., on 8/1/02, a provisional election was made with traverse to prosecute the invention of group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claim 15 is withdrawn

from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The abstract of the disclosure is objected to because in l. 2 catalyst should be plural, and in l. 9 organoaluminum is misspelled. Correction is required. See MPEP § 608.01(b).

7. The drawings are objected to because in figures 1 and 2, "organoaluminium" is spelled in the British manner, and in figure 2 the symbol Y is used to mean something other than yttrium, a group 3 metal. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. The draftsman has approved the drawings.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 11-15 of U.S. Patent No. 6,309,997. Although the conflicting claims are not identical, they are not patentably distinct from each other because the material limitations are essentially the same, only the order of recitation is inverted with the transition metal compound being first recited, then the cocatalysts in the issued patent.

10. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, l. 4, insert --the group consisting of-- after "selected from"; in l. 8 change "compound (A) to --compound (I)--; in l. 13 change "may be" to --are--; l. 20-23 conflict with l. 12 since m is given two different definitions; in l. 24 "satisfying the valence" would be better phrased --making (I) electrically neutral--; in l. 32 change "may be" to --are--.

In claim 3, l. 8, since m may only be one it is not clear why this prolix variable need be present; in l. 9 change "may be" to --are--; l. 21-23 contradicts l. 8 with regard to the definition of m; in l. 24 "satisfying the valence" would be better phrased --making (I) electrically neutral--; l. 25 to the end is prolix since these limitations are already found in claim 1.

In claim 5, l. 8, since m may only be one the prolix variable should be cancelled; however, l. 20-22 contradict the limitation on m in l. 8; these two conflicting definitions must be reconciled. In l. 9 and 28 change "may be" to --are--; in l. 23 "satisfying the valence" would be better phrased --making (I) electrically neutral--.

In claim 7, l. 16-18 contradict l. 8 regarding the definition of m; if m is only one, the variable should be deleted as prolix; in l. 9 change "may be" to --are--.

In claims 9-14, penultimate line of each, change "(A)" to --(I)--.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of US 2002/0082366 A1 (hereafter referred to as Johnson) or GB patent 1 390 530 (hereafter referred to as Schulz) in view of WO 96/28402 (hereafter referred to as Jacobsen).

Both Johnson (p. 1, formula II; paragraph 82, p. 5) and Schulz (p. 1, l. 65-69; p. 2, l. 1-8, l. 31-69) disclose the invention substantially as claimed.

Neither Johnson nor Schulz discloses that the metal of the transition metal compound may be from groups 3-7 or 11.

However, in a similar catalyst, Jacobsen teaches that the metal used may be from groups 3-12 (p. 2, l. 28-30; p. 5, l. 1-19).

It would have been obvious to one of ordinary skill in the art to apply the teaching of Jacobsen to the disclosures of either of Johnson or Schulz with a reasonable expectation of obtaining a highly-useful olefin polymerization catalyst with the expected benefit of the catalyst providing a stereospecific polypropylene.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is (703) 308-3497. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for normal faxes, 872-9311 for after final faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700

J. Pasterczyk

AU 1755

8/15/03